Remarks

Applicant respectfully requests reconsideration of the outstanding rejections in view of the above amendments and the following remarks.

Amendment to Specification is to correct an obvious error in the Related Art reference.

Non-Art Rejection

At present, Claims 7 and 10 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point our and distinctly claim the subject matter which applicant regards as the invention. Reconsideration of this rejection is requested in view of amendments.

In view of the above, these 35 U.S.C. §112, second paragraph, rejections cannot stand as a matter of law and should be withdrawn.

Art Rejection – Obviousness over Sullivan '855 in view of Sullivan '760

At present, Claims 1 – 6 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sullivan '855 in view of Sullivan '760. Applicant maintains that this rejection cannot stand for a number of reasons. Reconsideration of this rejection is thus requested.

Sullivan '855 is used for its teaching of (1) ionomers based on ethylene/acrylate/acid terpolymers with about 10 – 100% neutralization, and (2) the possibility to include metal stearates.

As was apparently clearly noted from the Amendment in Support of RCE, Sullivan '855 alone provides insufficient basis for rejection of Claims 1 – 6, and by extension Claim 10. Sullivan '855 cannot possibly suggest the limitation to "20 – 45 weight percent of the aliphatic, mono-functional organic acid". Sullivan '760 is used to fill this void, because it teaches that metal stearates, metal laurates, etc. in amounts of 25 – 75 pph are suitable additives to ionomer golf ball covers. Applicant respectfully traverses this rejection for several reasons.

First of all, it is well established patent law that it would not be obvious to modify a reference if the invention of the reference is destroyed in so doing as in this case. As fully argued and demonstrated in August 9, 2002, Amendment and Declaration under 37 C.F.R. § 1.132, filed in response to Office Action mailed April 17, 2002, Applicant maintains that Sullivan '855 teaches that metal stearates can only be used "as long as the desired properties produced by the golf ball covers of the invention are not impaired" (col. 5, ll. 21 –23). The desired property of the invention of Sullivan '855 is scuff resistance. As demonstrated, adding metal stearates results in poorer scuff resistance. So, one skilled in the art would find no motivation to modify Sullivan '855 by using the higher levels used in Sullivan '760. Instead, the skilled artisan would be lead away from doing so.

While as pointed out, the 90% acrylate ionomer requirement in Sullivan '855 may indeed be with reference to other ionomers in the cover, there is no suggestion in Sullivan '855 that high levels of fillers, metal stearates, etc. can be used. Nowhere in the four corners of Sullivan '855 are levels as high as 20 wt.% organic acid taught or suggested. To the contrary, high levels are taught away from as discussed above.

Second, patent law clearly requires the references to be taken as a whole. By ignoring the clear restriction on using "softening agents such as those disclosed in U.S. Pat. Nos. 5,312,857 and 5,306,760 (Sullivan '760)" discussed above, the reference is not being taken as a whole. There can be no motivation to combine Sullivan '760 with Sullivan '855, when Sullivan '855 itself says not to do so when the invention of Sullivan '855 is destroyed.

Third, patent law requires that, in addition to the reference being taken as a whole, the claims being examined must also be taken as a whole. So, even if there were a basis for combining Sullivan '760 with Sullivan '855, the claims taken as a whole would not be met by the references taken as a whole. For example, while Sullivan '855 may teach neutralization of about 10 – 100%, it does not teach 20 – 45 wt.% organic acid or salt thereof at any neutralization level and particularly at neutralization levels greater than 90% as presently claimed. While Sullivan '760 may teach organic acid salts at 25 – 75 pph, it does not teach such levels at neutralization levels greater than 90%.

Instead, Sullivan '760 is limited to neutralization levels of 15 – 75% (see col. 8, ll. 3 –5, and examples where in no case is a neutralization reported as greater than 70%). Thus, taking the references as a whole, at most one skilled in the art would not be lead to the claimed combination of 20 – 45 wt.% organic acid with greater than 90% neutralization.

Thus, this obviousness rejection cannot stand as a matter of law and should be withdrawn.

Art Rejection – Obviousness over Sullivan '855 in view of Sullivan '760 further in view of Bush '578 and Rees '134

At present, Claims 1 – 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sullivan '855 in view of Sullivan '760 in further view of Bush '578 and Rees '134. Reconsideration of this rejection is requested.

First of all, even if Bush or Rees suggest post neutralization as maintained in the present office action, neither would cure any of the defects left as discussed above. For this reason alone, Applicant maintains that the combination would neither teach nor suggest the claims taken as a whole.

As for whether Bush or Rees suggests post neutralization in combination with other limits in the present claims, Applicant respectfully points the examiner to the discussion in the August 9, 2002, Amendment. Example 64 in Rees '134 apparently suggests that first zinc oxide is added and then stearic acid is added to ethylene methacrylic acid and that no neutralization occurs. Following these two additions, acetic acid is added and only then does a reaction take place. Bush '578 only teaches a conventional method of making ionomer. It does not teach pre-blending and organic acid with an acid copolymer and then neutralizing. Even if these two references suggest post-neutralization, they would not suggest all the limits of the present invention, particularly obtaining neutralization of greater than 90%.

Thus, this obviousness rejection cannot stand as a matter of law and should be withdrawn.

Conclusion

In view of the above remarks and the enclosed amendments, it is felt that all claims are now in condition for allowance and such action is requested. Should the Examiner believe that an interview or other action in Applicants' behalf would expedite prosecution of the application, the Examiner is urged to contact Applicant's attorney by telephone at (302) 992-3219.

Respectfully submitted,

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